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REMARKS

As set forth in the Office Action, of pending Claims 1-12, 14, 23-27 and 37 in the Application, (i) Claim 24 was rejected under 35 U.S.C. § 112 as being indefinite for the reason stated therein; (ii) Claims 1 and its dependent Claims 2, 3, 6, 7, 8, 10, 11, 12, 23, 24, and 37 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,280,441 to Ryan (Ryan); (iii) Claims 4, 5, 9, 14, 25, and 27 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over Ryan in view of U.S. Patent No. 5,891,134 to Goble et al (Goble); and (iv) Claims 24 and 37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ryan in view of U.S. Patent No. 4,832,048 to Cohen (Cohen), also for the stated reasons stated therein.

By the present reply, the Applicant has amended Claims 1, 6, 9, and 12; Claims 23, 24 and 26 are cancelled; and new Claim 83 is being presented for inclusion in the Application. Support for new Claim 83 can be found, for example, in Fig. 16 B and at page 43, line 3, ff of the originally filed Application. Consequently, with the inclusion of Claim 83, Claims 1-12, 14, 25, 27, 37 and 83 are pending.

Regarding the 35 U.S.C. § 112 rejection of Claim 24 (dependent upon Claim 23), by the present amendment, since the spacer as set forth in Claim 23 is now specified in Claim 1 as amended, therefore both Claim 23 and 24 are now redundant, and thus are deleted. Accordingly, since this grounds for rejecting Claim 24 is now moot, therefore the Applicant respectfully requests withdrawal of this basis for rejecting Claim 24.

Regarding the 35 U.S.C. § 102 (e) rejection of Claim 1 and its dependent claims over Ryan, Claim 1 has been amended to particularly point out and distinctly claim the Applicant's probe comprising: a shaft having a distal end portion comprising a substantially linear active electrode filament projecting from said shaft; a return electrode; and a spacer disposed between said return electrode and said active electrode filament, said spacer encircling said active electrode filament, said return electrode having a distal terminal portion configured into a return electrode coil defining turns disposed around said spacer and said active electrode filament.

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Support for the amendment to Claim 1 can found at, for example, at (i) page 43, line 4 and in Fig. 16 B wherein a substantially linear active electrode filament (1034) is clearly shown to be projecting from the distal end of the shaft (1002b); (ii) in Fig. 16 B for a spacer (1016) disposed between the return electrode (1024) and the active electrode filament, (iii) in Fig. 16 C, for the spacer encircling the active electrode filament; (iv) in Fig 16 B for the return electrode distal end portion (1022) configured into a coil defining turns disposed around the spacer and the active electrode filament.

In thus amending Claim 1 to specify that that the Applicant's probe includes a substantially linear active electrode element separated from the return electrode by a spacer, and wherein the distal terminal portion [is] configured into a return electrode coil defining turns disposed around [i.e., encircling] the spacer and the active electrode element, the Applicant's invention is clearly and patentably distinct since the claimed features of the Applicant's invention is neither taught nor suggested by Ryan.

In this regard, the Applicant notes that Ryan neither teaches nor suggests the applicant's claimed invention as set forth in Claim 1 as Ryan does not teach a substantially linear active element wherein a distal terminal portion of a return electrode is configured into a coil around the active electrode element.

On the contrary, Ryan teaches a device having a helical tip designed for penetrating tissue using a semi rigid and helical effector comprising the active and return electrodes wrapped around each other as in a helix, at the distal end of an axis, the effector having a sharpened distal tip for penetrating tissue (see for example, Ryan's Fig. 1, 6 12, and 14, and Col 5, lines 5 and following). Consequently, since the Applicant's invention is not taught or suggested by Ryan, the Applicant respectfully request withdrawal of the rejection and reconsideration of Claim 1 as amended.

Similarly, and with regard to the 35 U.S.C. § 103 rejection of the claims, since the Applicant's invention as set fort in Claim 1 is neither taught by Ryan, Goble or Cohen, nor suggested by Ryan in view of either Goble or Cohen, therefore the claims as amended defined patentable inventions under 35 U.S.C. § 103(a). Consequently, the Applicant also respectfully

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requests withdrawal of rejection of the claims on this grounds and reconsideration of the claims as amended.

Accordingly, since the claims as amended are neither disclosed nor suggested by the cited references, and since the claims are supported by the specification as filed, the Applicant respectfully request redrawal of all rejections, reconsideration of the claims as amended and allowance of the Application.

SUMMARY

By the present amendments and remarks the Applicant believes that the bases for rejections as set for in the Office Action have been addressed and that the Application is in condition for allowance. The Applicant therefore respectfully requests reconsideration of the claims and allowance of the Application. If any issue is still outstanding and a telephone conference would expedite prosecution of the Application, kindly telephone the undersigned at (408) 736-6486.

Respectfully submitted,



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